

ARGUMENTS / REMARKS

In response to the Office Action dated September 9, 2005, Applicant respectfully requests the Office to enter the amendments set forth above and consider the following remarks. By this response, Applicant amends claims 1, 8, 13, and 18, cancels claims 2, 3, and 19 without prejudice or disclaimer, and adds new claims 24-25. After entry of this paper, claims 1, 4-18, and 20-25 will be pending in this application.

In the Office Action, the Examiner: (i) rejected claims 8 and 18-23 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite; (ii) rejected claims 1-8, 10, and 17 under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,314,180 to Yamagishi ("Yamagishi"); (ii) rejected claims 9, 11, and 12 under 35 U.S.C. § 103(a) as allegedly unpatentable over Yamagishi in view of the knowledge of one skilled in the art; (iii) rejected claim 16 under 35 U.S.C. § 103(a) as allegedly unpatentable over Yamagishi in view of U.S. Patent Application Publication No. 2003/0073523 to Hsu ("Hsu"); and (iv) indicated that claims 13-15 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

35 U.S.C. § 112, ¶ 2, Rejections

Claims 8 and 18-23 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Without acquiescing to the rejection, Applicant has amended claims 8 and 18 to correct a typographical error and to characterize the dampening material, respectively. The amendment to claim 18 extends to its dependent claims, claims 19-23. Accordingly, Applicant respectfully requests that the rejection of claims 1 and 18-23 under 35 U.S.C. § 112, second paragraph, be withdrawn.

35 U.S.C. § 102(b) Rejections

Claims 1-8, 10, and 17 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Yamagishi.

Without acquiescing to the rejection and in the interest of expediting prosecution, Applicant has amended claim 1 to further clarify the recited invention over the cited art. Specifically, claim 1 has been amended to recite a racket "wherein a plurality of discrete dampening layers are arranged in pairs and essentially symmetrical with respect to the longitudinal axis of the racket" and "wherein a dampening layer is provided in an area between four o'clock and six o'clock and a further dampening layer in an area between six o'clock and eight o'clock on the racket head." No new matter has been added via these amendments. Applicant respectfully asserts that Yamagishi does not teach or suggest the combination of features now recited.

For example, the recitations "a plurality of discrete dampening layers" including one dampening layer "provided in an area between four o'clock and six o'clock and a further dampening layer in an area between six o'clock and eight o'clock on the racket head," are not found in Yamagishi. Instead, Yamagishi discloses a dampening layer that surrounds the entire racket head (see, e.g., Fig. 3), with no teaching or suggestion of discrete dampening layers in certain areas of the racket head whatsoever. Therefore, Yamagishi cannot anticipate amended claims 1 due to its failure to teach or suggest discrete dampening layers in an area between four o'clock and six o'clock and in an area between six o'clock and eight o'clock. Further, this structural difference between the claimed racket and the cited art provides improved handling characteristics, as set forth in more detail in connection with the 35 U.S.C. §103(a) discussion below. For at least these reasons, Applicant respectfully requests that the rejection of claim 1 under 35 U.S.C. §102(b) be withdrawn and the claim allowed. Additionally, claims 2-8, 10, and 17, which directly or indirectly depend from claim 1, are allowable for at least the same reasons.

35 U.S.C. § 103(a) Rejections

Claims 9, 11, and 12 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Yamagishi in view of the knowledge of a person having ordinary skill in this art.

Claim 16 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Yamagishi in view of Hsu.

Again, without acquiescing to the rejection and in the interest of expediting prosecution, Applicant has amended claim 1, from which claims 9, 11, 12 and 16 depend, to further clarify the recited invention over the cited art. Specifically, claim 1 has been amended to recite a racket "wherein a plurality of discrete dampening layers are arranged in pairs and essentially symmetrical with respect to the longitudinal axis of the racket" and "wherein a dampening layer is provided in an area between four o'clock and six o'clock and a further dampening layer in an area between six o'clock and eight o'clock on the racket head." Applicant respectfully asserts that the cited references and the knowledge of an ordinary artisan fail to render unpatentable the combination of features now recited.

For example, the Office's primary reference, Yamagishi, discloses a racket 1 comprising a frame portion 2, a throat portion 3 and a grip portion 4. In Yamagishi, a vibration-reducing material 5 can be used in three ways, as a part of the material constituting: (i) the rib portion 4 (Fig. 2 embodiment), (ii) the throat portion 3 and the grip portion 4 (Fig. 1 embodiment), or (iii) the frame portion 2, the throat portion 3 and the grip portion 4 (Fig. 3 embodiment).

However, a racket consistent with the presently-claimed invention differs from Yamagishi in that dampening layers are arranged in discrete areas of the racket head. In Yamagishi, the vibration reducing material is only provided in the grip portion 4 (Fig. 2), in the grip portion 4 and the grip portion 3 (Fig. 1), or throughout the racket frame, i.e., in the grip portion 4, the throat portion 3 and the frame portion 2 (Fig. 3). Accordingly, Yamagishi fails to teach or suggest discrete dampening layers located within the recited areas of the racket head (i.e., in the area between four o'clock and six o'clock and between six o'clock and eight o'clock on the racket head), as now specified in the amended claims.

Furthermore, neither the knowledge of a person having ordinary skill in this art nor Hsu cure the deficiencies in Yamagishi stated above.

Factual evidence concerning the advantages of the amended claims also supports the patentability of the pending claims over the cited art. Specifically, Applicant has taken measurements on various rackets in order to demonstrate the effects of the presently-claimed dampening layers over rackets without such layers,

such as the cited art here. Applicant attaches a diagram showing how the position and size of the dampening layer on the racket head influences the deformation of the racket under load. This diagram shows the deformation of the racket in millimeters at specific measurement sites. The measurement site is illustrated on the x-axis of the diagram, wherein the respective measurement site is defined as a distance from the outermost head end of the racket. The y-axis shows the deformation of the racket in millimeters. As can be taken from the diagram, three different rackets were tested, namely a first racket with the designation "175-R0-H0" (dotted line), a second racket with the designation "175-R55-H0" (dashed line), and a third racket with the designation "175-R110-H0" (solid line). As used in the diagram, "175" is a specification of a specific racket, "R..." indicates the length of the dampening layer in the direction of the extension of the frame (i.e., "R0" relates to a racket without dampening layer, "R55" is a racket with a dampening layer having a length of 55 mm, and "R110" is a racket with a dampening layer having a length of 110 mm). The dampening layers are arranged at about five o'clock and seven o'clock which are the centers of the claimed ranges of between four o'clock and six o'clock as well as between six o'clock and eight o'clock.

As seen from the diagram, the use of a dampening layer makes the racket "softer" because a higher deformation occurs under load. This can be seen with the dashed line and particularly with the solid line in comparison to the dotted line (no dampening layer). Furthermore, as also seen in the diagram, the three tested rackets behave relatively similar in the throat region and a region towards the head end of the racket (i.e., at a distance of less than about 150 mm from the head end). In the area of the dampening layer, i.e., at about 250 to 320 mm away from the head end, significant differences in deformation can be seen between the rackets of the present invention and the racket without a dampening layer.

In sum, a racket according to claims 9, 11, 12, and 16 of the present invention differs structurally from the rackets asserted by the Office. Additionally, it also provides improved handling characteristics consistent with the recitations now present in the amended claims. Thus, the limitations of presently-claimed racket are not obvious in view of the cited art.

Therefore, for at least the above reasons, Applicant respectfully submits that claims 9, 11, 12, and 16 are patentable over Yamagishi, Hsu, and the knowledge of a person having ordinary skill in this art. Accordingly, Applicant respectfully requests that the rejection of claims 9, 11, 12, and 16 under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

Allowable Subject Matter

The Examiner stated that claims 13-15 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant has rewritten these claims in independent form, and respectfully requests timely allowance of these claims.

Conclusion

Finally, Applicant submits herewith an Information Disclosure Statement listing references for consideration by the Office.

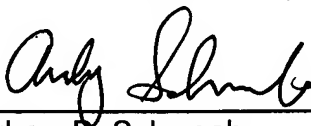
In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Attachments: Exhibit A - Diagram of test results

Exhibit A

